

*Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. §112, the Examiner must provide a basis and fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. §112. *Zoltek Corp. v. United States*, supra; *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). Applicants stress that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. *Zoltek Corp. v. United States*, supra; *Miles Laboratories, Inc. v. Shandon, Inc.*, supra; *Budde v. Harley-Davidson, Inc.* \_\_\_F.3d\_\_\_, 58 USPQ2d 1801 (Fed. Cir. 2001).

In applying the above legal tenets to the exigencies of this case, Applicants respectfully submit that the Examiner did not discharge the initial burden of providing a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion

that one having ordinary skill in the art would not be able to ascertain the scope of protection defined by the claims, when reasonably interpreted in light of and consistent with the supporting specification. Specifically, merely posing questions falls far short of discharging the initial burden of providing a basis to support the asserted definiteness under the second paragraph of 35 U.S.C. §112. Applicants are fully aware that they, and they alone under the statute, have the right to claim what **they** regard as their invention. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979); *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).

The question is not one of English grammar. Rather, as previously pointed out, regardless of what the Examiner views as "vague, indefinite, and/or awkwardly and confusingly worded", the question is whether one having ordinary skill in the art would have been able to understand the scope of the invention when reasonable interpreted in light of and consistent with the written description of the specification. *Zoltek Corp. v. United States*, supra; *Miles Laboratories, Inc. v. Shandon, Inc.*, supra;

At any rate, Applicants would respond by noting that claim 1 is drawn to a method, that method comprises the manipulative step of using "a flawing tool" as part of that method. The manipulative step requires the formation of a continuous flaw with a flawing tool. Applicants have difficulty conceiving of one having ordinary skill in the art who would not have understood the scope of that manipulative step and, apart from asking a question, the Examiner has not provided any basis to support the legal conclusion that the

recited manipulative step of forming a continuous flaw runs a foul of the second paragraph of 35 U.S.C. §112.

Claim 1 further requires the manipulative step of dividing the ceramic sintered base plate by applying an external force. The Examiner's question is not understood. Again, Applicants have difficulty conceiving of one having ordinary skill in the art who would not have understood the claimed invention. Questions do not provide the requisite basis to support the ultimate legal conclusion of indefiniteness under the second paragraph of 35 U.S.C. §112.

Claim 2 specifies that the flawing tool is made of a cemented carbide or diamond. Manifestly, the claimed method requires the use of a flawing tool which is made of a ceramic carbide. Had Applicants intended to claim a method of making a flawing tool, then Applicants would have done so. Rather, Applicants are claiming a method of producing ceramic base plates by a method which includes, inter alia., forming a continuous flaw using a flawing tool which, in turn, is made of a cemented carbide or diamond. Applicants would stress that consistent judicial precedent requires that claims be interpreted in light of and consistent with the written description of the specification through the eyes of one having ordinary skill in the art. *Zoltek Corp. v. United States, supra.*; *Miles Laboratories, Inc. v. Shandon, Inc., supra.*

As to the comments with respect to claim 7, the Examiner is respectfully requested to cite a statutory or judicial basis for concluding a negative limitation, per se,

renders a claim indefinite. Applicants have the right to define what **they** regard as **their** invention. *In re Ehrreich, supra.; In re Borkowski, supra.* Negative limitations, per se, do not render a claimed invention indefinite. *In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).* Applicants are free to define what they regard as their invention. . *In re Ehrreich, supra.; In re Borkowski, supra.*

In the statement of the rejection, the Examiner also asserted that claims 5 through 7 are improperly dependent and do not further restrict the subject matter of a previous claim. Applicants disagree. What is the basis for the Examiner's assertions? Applicants find nothing in the Examiner's exposition of the rejection which in any way attempts to reflect how one having ordinary skill in the art would have interpreted the claims in light of and consistent with the written description of the specification as judicially required. *Zoltek Corp. v. United States, supra.; Miles Laboratories, Inc. v. Shandon, Inc., supra.*

Claims 5 through 7 do, indeed, restrict the claims upon which they depend by requiring the selection of a ceramic sintered base plate with a particular hardness (claim 5), made of a particular material (claim 6), and in eschewing the using of a cooling medium (claim 7). Again, indefiniteness under the second paragraph of 35 U.S.C. §112 is not a matter of grammar or syntax, but of law. *Zoltek Corp. v. United States, supra.; Personalized Media Communications LLC v. U.S. International Trade Commission, supra.; Tillotson Ltd. v. Walbro Corp., supra.; Orthokinetics Inc. v. Safety Travel Chairs Inc., supra.*

Based upon the foregoing, it should be apparent that a prima facie basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. §112 has not been established. Applicants, therefore, submit that the imposed rejection of claims 1 through 7 under the second paragraph of 35 U.S.C. §112 is legally erroneous and, hence, solicit withdrawal thereof.

**Claims 1 and 7 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Sucarrats.**

In the Request for Reconsideration submitted February 20, 2001, it was argued that the Examiner did not identify wherein Sucarrats discloses a ceramic sintered base plate. The Examiner now asserts that the disclosure of Sucarrats encompasses sintered base plates. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, and quite significantly, in imposing a rejection under 35 U.S.C. §102, the Examiner is required to specifically identify, i.e., point to "page and line", wherein a reference is believed to disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ

481 (*Fed. Cir. 1984*). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the methodology of Sucarrats that scotch the factual determination that Sucarrats identically describes the claimed invention within the meaning of 35 U.S.C. §102.

Specifically, as argued in the Request for Reconsideration submitted February 20, 2001, the method defined in independent claim 1 requires the manipulative step of forming a continuous flaw on at least one surface of a ceramic **sintered base plate**. It is not apparent and the Examiner has not pointed to "page and line" wherein Sucarrats discloses a method involving a sintered base plate. *In re Rijckaert, supra.; Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.* Rather, the Examiner generalizes without any factual support, asserting that the ceramic tiles and plates disclosed by Sucarrats "encompasses ceramic sintered base plates." Firstly, the Examiner's speculation falls short of establishing, by **facts**, lack of novelty as required by consistent judicial precedent. *W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)*. Secondly, the Examiner has not identified in the prior art any basis in fact upon which to support the conclusion that any articles contemplated by Sucarrats would necessarily include sintered base plates.

Thirdly, the Examiner has not factually established that the tool disclosed by Sucarrats is even capable of scoring a ceramic sintered base plate. Applicants, therefore, question whether Sucarrats would have enabled one having ordinary skill in the art to cut a ceramic sintered base plate. Applicants, therefore, submit that Sucarrats is nonenabling

with respect to the claimed invention. *Beckman Instruments, Inc. v. LKB Productter AB*, 892 F.2d 1547, 13 USPQ2d 1301 (Fed. Cir. 1989); *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979). Nonenabling references do not place the claimed invention into possession of one having ordinary skill in the art. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 167 (Fed. Cir. 1994; *In re Grose*, *supra*.

The above argued differences between the claimed invention and the methodology of Sucarrats undermines the factual determination that Sucarrats identically describes the claimed invention within the meaning of 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicants, therefore, submit that the imposed rejection of claims 1 and 7 under 35 U.S.C. §102 for lack of novelty as evidenced by Sucarrats is not factually viable and, hence, solicit withdrawal thereof.

**Claims 2 through 6 were rejected under 35 U.S.C. §103 for obviousness predicated upon Sucarrats in view of Yasuga.**

In the statement of the rejection, the Examiner concluded that one having ordinary skill in the art would have been motivated to conduct the method disclosed by Sucarrats employing a diamond flawing tool as disclosed by Yasuga. The Examiner considered the

depth of the flaw and the material of the base plate to be obvious. This rejection is traversed.

Firstly, claims 2 through 6 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §102 for lack of novelty based upon Sucarrats. Specifically, Sucarrats neither discloses nor suggests the fundamental concept of forming a continuous flaw on at least one surface of a ceramic sintered base plate. The secondary reference to Yasuga does not cure the argued deficiencies of Sucarrats. Accordingly, even if the applied references are combined, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Furthermore, Applicants separately argue the patentability of claims 4 through 6. Specifically, the Examiner has made no "clear and particular" factual findings as to a specific understanding or a specific technological principle which would have realistically impelled one having ordinary skill in the art to further modify the methodology of Sucarrats to arrive at a method as defined in claims 4 through 6, wherein the depth of the flaw, hardness of the ceramic sintered base plate and material of the base plate are specified, based upon facts -- not generalizations. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolchem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Significantly, the Examiner has failed to establish by objective evidence that the



parameters recited in each of claims 4 through 6 are, indeed, art-recognized result effective variables. *In re Rijckaert, supra.*; *In re Yates*, 663 F.2d 1054, 211 USPQ 1149 (CCPA 1981); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

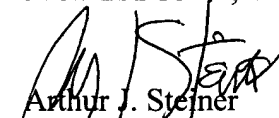
Applicants, therefore, respectfully submit that the imposed rejection of claims 2 through 6 under 35 U.S.C. §103 for obviousness predicated upon Sucarrats in view of Yasuga is not factually or legally viable and, hence, solicit withdrawal thereof.

It should, therefore, be apparent that the imposed rejections of record have been overcome, and that this application is in condition for allowance. Accordingly, favorable consideration is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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